

REMARKS

Claim 10 is amended, no additional claims are canceled, and no new claims are added with this response; as a result, claims 1-2 and 6-23 are now pending in this application.

No new matter has been introduced through the amendments to claim 10. Claim 10 was amended merely to change the dependency of claim 10 from claim 7 to claim 8.

Double Patenting Rejections

Claims 1, 2, and 6-23 were rejected under a non-statutory, obviousness-type double patenting rejection, specifically over claims 1-24 of U.S. Patent No. 6,687,539. Applicants do not admit that claims 1-2 and 6-23 are obvious in view of claims 1-24 of U.S. Patent No. 6,687,539. Applicants will revisit the issue and, if appropriate, submit a terminal disclaimer to obviate this rejection when the claims of the above-referenced patent application are otherwise considered allowable.

Claims 1, 2, and 6-23 were rejected under a non-statutory, obviousness-type double patenting rejection, specifically over claims 1-7 of U.S. Patent No. 6,304,778. Applicants do not admit that claims 1, 2, and 6-23 are obvious in view of claims 1-7 of U.S. Patent No. 6,304,778. Applicants will revisit the issue and, if appropriate, submit a terminal disclaimer to obviate this rejection when the claims of the above-referenced patent application are otherwise considered allowable.

§102 Rejection of the Claims

Claims 1, 2, 8, 11-15, 17-19, 22, and 23 were rejected under 35 U.S.C. § 102(e) for anticipation by Struble et al. (U.S. Patent No. 6,122,545). Applicants respectfully traverse the rejection of claims 1, 2, 8, 11-15, 17-19, 22, and 23.

Claims 1, 2, 8, 11-15, 17-19, 22, and 23 are not anticipated by Struble et al. because Struble et al. fails to disclose in a single reference all of the subject matter included in each of claims 1, 2, 8, 11-15, 17-19, 22, and 23, as arranged in each of claims 1, 2, 8, 11-15, 17-19, 22,

and 23,¹ and so fails to show the identical claimed invention as included in claims 1, 2, 8, 11-15, 17-19, 22 and 23.²

By way of illustration, claim 1 includes:

a programmable memory device for storing one or more cross-chamber blanking settings; and
circuitry for blanking an effect of atrial electrical signals in the monitoring circuitry for a period of time based on at least one of the cross-chamber blanking settings.

In contrast to the subject matter of claim 1, Struble et al. concerns:³

A pacing pulse delivered to one heart chamber at the expiration of an escape interval or an AV delay evokes a paced event and starts a paced event CDW (CDW^P) for the sensing of a conducted depolarization in the other heart chamber. Pacing in the other heart chamber is inhibited if a conducted depolarization is sensed as a sensed event within the CDW^S or the CDW^P. Similarly, a pacing pulse is delivered to that heart chamber at the end of the CDW^S or the CDW^P if the CDW^S or the CDW^P times out without sensing a sensed event in that heart chamber. Each CDW^S and CDW^P for timing conduction of spontaneous or evoked depolarizations from the right and left heart chambers to the left and right heart chambers, respectively, is separately programmable in length. The provision of the separate sense CDW^S and pace CDW^P allows compensation for conduction delay differences that may exist in conduction of a depolarization that spontaneously occurs or is evoked by delivery of a pacing pulse.

However, a discussion in Struble et al of starting a paced event CDW for the sensing of a conducted depolarization in the other heart chamber, as described in Struble et al., fails to disclose the subject matter of claim 1 as quoted above, including, "circuitry for *blanking an effect of atrial electrical signals in the monitoring circuitry* for a period of time based on at least one of the cross-chamber blanking settings," as required by claim 1. (Emphasis added). Therefore,

¹Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W. L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, A[nticipation] requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

²The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP '2131.

³See Struble et al. at column 6, line 60 through column 7, line 10.

Struble et al. fails to disclose all of the subject matter included in claim 1, and so claim 1 is not anticipated by Struble et al.

For reasons analogous to those stated above with respect to claim 1, Struble et al. fails to disclose all of the subject matter in any one of independent claims 2, 8, 11, 17, and 22, or any of claims 12-15, 18-19, and 23 that depend from one of independent claims 11, 17, and 22.

Therefore, Struble et al. fails to disclose the subject matter included in claims 2, 8, 11-15, 17-19, 22, and 23, and so claims 2, 8, 11-15, 17-19, 22, and 23 are not anticipated by Struble et al.

Further, the statement in the Office Action used in the rejection of claims 1, 2, 8, 11-15, 17-19, 22, and 23 merely states: "Struble is considered to anticipate all of the structure of the above claims."⁴ Such a statement fails to meet the requirements for the Office Action to point out the particular part of the document relied on as forming a basis for the rejection.⁵

For at least the reasons stated above, the Office Action fails to meet its burden for establishing a *prima facie* case of anticipation with respect to the rejection of claims 1, 2, 8, 11-15, 17-19, 22, and 23.

Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 1, 2, 8, 11-15, 17-19, 22, and 23.

§103 Rejection of the Claims

Claims 6-7, 10, 16, and 20-21.

Claims 6, 7, 10, 16, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Struble et al. (U.S. Patent No. 6,122,545) in view of Wickham (U.S. Patent No. 5,891,171).

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Struble et al. (U.S. Patent No. 6,122,545) in view of van Lake (U.S. Patent No. 5,653,737).

⁴ See the Office Action at page 2, second sentence under the heading "*Claim Rejections-35 USC § 102.*" (Emphasis in original).

⁵ See 37 CFR 1.104 Nature of Examination (2) which states: "(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

Applicants respectfully traverse the rejection of claims 6, 7, 10, 16, 20, and 21 in view of the proposed combination of Struble et al. and Wickham.⁶ Further, Applicants respectfully traverse the rejection of claim 9 in view of the proposed combination of Struble et al. and van Lake.⁷

Claims 6-7, 9-10, 16, and 20-21 depend from one of independent claims 1, 2, 8, 11, and 17, and so include all of the subject matter included in the independent claim from which they depend, and more.

With respect to claims 6, 7, 10, 16, 20, and 21, Applicants believe for at least the reasons stated above that Struble et al. fails to disclose or suggest all of the subject matter included in independent claims 1, 2, 8, 11, and 17, and therefore fails to disclose or suggest all of the subject matter including in claims 6-7, 9-10, 16, and 20-21. Applicants fails to find in, and the Office Action fails to point out where Wickham discloses or suggests the subject matter included in claims 6, 7, 10, 16, 20, and 21 and missing from Struble et al. Thus, claims 6, 7, 10, 16, 20, and 21 are not obvious in view of the proposed combination of Struble et al. and Wickham.

With respect to claim 9, Applicants believe for at least the reasons stated above that Struble et al. fails to disclose or suggest all of the subject matter included in independent claim 8, and therefore fails to disclose or suggest all of the subject matter including in claim 9, which depends from claim 8. Applicants fails to find in, and the Office Action fails to point out where van Lake discloses or suggests the subject matter included in claim 9 and missing from Struble et al. Thus, claim 9 is not obvious in view of the proposed combination of Struble et al. and van Lake.

Further, the Office Action fails to specifically point out in any of the documents including Struble et al., Wickham, and van Lake, where there is any disclosure or suggestion of the subject matter included in any one of claims 6-7, 9-10, 16, and 20-21 that could be used as a basis for the 35 U.S.C. § 103 rejections of these claims. Without such a showing, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to claims 6-7, 9-10, 16, and 20-21.

⁶ Applicants do not admit or agree that any combination of Struble et al. and Wickham is possible.

⁷ Applicants do not admit or agree that any combination of Struble et al. and van Lake is possible.

Still further, the Office Action refers to seeing "the previous office action regarding the obviousness of combining the teachings of Wickham with Struble,"⁸ and "regarding the obviousness of combining the teachings of van Lake with Struble."⁹ However, since Struble et al. was never cited in any previous office actions in this application, this statement fails to provide any possible basis for forming the proposed combinations that would include Struble et al.

Applicants respectfully requests reconsideration and withdrawal of the rejection, and allowance of claims 6-7, 9-10, 16, and 20-21.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

⁸ See the Office Action at page 2, last sentence.

⁹ See the Office Action at page 3, second sentence under item number 5.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date OCTOBER 25/2007

By Robert B. Madden

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25 day of October 2007.

Nicole Allen

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Signature